



06-22-05

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en  
PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Docket No. 01-298)

In re the Application of: )  
)  
Sundar Raman et al. )  
) Group Art Unit: 2645  
Serial No.: 09/849,834 )  
) Examiner: Allan Hoosain  
Filed: May 4, 2001 )  
) Confirmation No.: 2255  
For: SYSTEM AND METHOD TO ALLOW SIMPLE )  
IP MOBILE NODES TO OPERATE )  
SEAMLESSLY IN A MOBILE IP NETWORK )  
WITH TRUE ROAMING CAPABILITIES )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

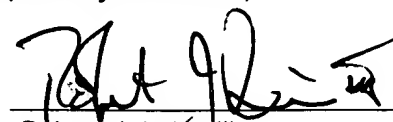
**TRANSMITTAL LETTER**

Sir:

In regard to the above identified application:

1. We are transmitting herewith the attached:
  - a. Resubmission Of Supplemental Information Disclosure Statement;
  - b. Copy of previously submitted Transmittal letter;
  - c. Copy of previously submitted Supplemental Information Disclosure Statement;
  - d. Copy of previously submitted Supplemental Form PTO-1449;
  - e. Copy of previously submitted IDS citation (Declaration of U.S. Patent Application 09/849,834);
  - f. Copy of previously submitted postcard with the USPTO receipt stamp; and
  - g. Return Receipt Postcard.
2. With respect to additional fees:
  - a. No fees are due.
  - b. Please charge any additional fees or credit overpayment to our Deposit Account No.13-2490. A duplicate copy of this sheet is enclosed.
3. CERTIFICATE OF MAILING UNDER 37 CFR § 1.10: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee," addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 21, 2005 under Express Mail Certificate No. EV596661134US.

Respectfully submitted,

By:   
Robert J. Irvine III  
Reg. No. 41,865



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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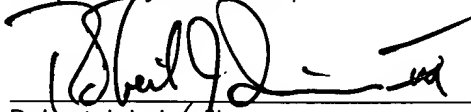
**RESUBMISSION OF SUPPLEMENTAL  
INFORMATION DISCLOSURE STATEMENT**

Applicants previously submitted the Supplemental Information Disclosure Statement (IDS), however, have not received the initialed 1449 Form back from the Examiner. Therefore, Applicants are resubmitting the IDS and request that they be initialed and returned by the Examiner.

The IDS was received by the USPTO, as evidenced by the stamped postcard receipt. Because the IDS was previously submitted and received by the USPTO, Applicants believe that no fee is required for this resubmission.

If the Examiner has any remaining questions or issues, Applicant's attorney, Robert J. Irvine III, may be reached at his direct dial number at 312-913-3305.

Respectfully submitted,

  
Robert J. Irvine III  
Registration No. 41,865

Date: June 21, 2005



PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

(Case No. 01-298)

IN THE APPLICATION OF:

Raman et al.

Serial No. 09/849,834

Filed: May 4, 2001

Title System And Method To Allow  
Simple IP Mobile Nodes To Operate  
Seamlessly In A Mobile IP Network  
With True Roaming Capabilities

Examiner: To be assigned

Group Art Unit: 2681

Confirmation No.: 2255

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached:

- a. Information Disclosure Statement;
- b. Form PTO-1449;
- c. One IDS Citation (Declaration for U.S. Patent Application 09/849,834); and
- d. Return Receipt Postcard.

2. With respect to additional fees:

☒ No additional fee is required.

3. Please charge any additional fees or credit overpayment to Deposit Account No.13-2490. A duplicate copy of this sheet is enclosed.

4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29<sup>th</sup> day of May, 2003.

By:

Robert J. Irvine III

Reg. No. 41,865

McDONNELL BOEHNEN,  
HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
CHICAGO, ILLINOIS 60606  
TELEPHONE (312) 913-0001



PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 01-298)

IN THE APPLICATION OF:

Raman et al.

Serial No. 09/849,834

Filed: May 4, 2001

Title System And Method To Allow  
Simple IP Mobile Nodes To Operate  
Seamlessly In A Mobile IP Network  
With True Roaming Capabilities

Examiner: To be assigned

Group Art Unit: 2681

Confirmation 2255  
No.:

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure provided by 35 C.F.R. § 1.56 and §§ 1.97-98, the applicants wish to make the following information of record in the above-identified application. It is requested that the information be given careful consideration and that it be cited of record in the prosecution history of the present application. An information declaration is enclosed and is also listed in the PTO-1449 form also enclosed herewith.

Portions of the information may be material to the examination of the pending claims, however no such admission is intended. 37 C.F.R. 1.97 (h). This Statement is not a representation that the cited information has an effective date early enough to be "prior art" within the meaning of 35 U.S.C. sections 102 or 103, nor is this submission to be construed as a representation that a search has been made.

### **CITED INFORMATION**

Applicants and their counsel recently became aware of development activities in which assignee, 3Com, was involved. Upon investigation of the activities, it was concluded that these do not negatively impact the patentability of the present invention but may be considered to be relevant to the present prosecution. Therefore, out of an abundance of caution and to ensure the record is complete, applicants disclose herein 3Com's activity in the technology area of the invention. The documents associated with this activity are subject to a non-disclosure agreement and are therefore not provided. However, applicant submits that the following description along with the attached declaration of Mr. Lee Rosenbaum should be sufficient for the Office to reach a conclusion on the relevance of the information.

### **Factual Background**

Beginning in February 1999, 3Com and Motorola entered into an agreement under which 3Com would provide Motorola with Mobile Access Routing Card ("MARC card") technology for use with Motorola's wireless technology. In late 1999/early 2000 3Com and Motorola entered into an amended agreement. Under the amended agreement 3Com was to develop and provide to Motorola a MARC card that included Mobile Proxy Agent ("MPA") functionality consistent with an agreed upon specification. Pursuant to this agreement and a non-disclosure agreement, 3Com provided Motorola with an early version of the software for a MARC card that included MPA functionality on or about January 21, 2000. However, at that time and up to and through the critical date the software was subject to testing. There was no knowledge that the software worked in the claimed system before the critical date.

The Motorola agreement did not include providing Motorola with the invention as currently claimed. The current claims are directed to a method and system wherein a mobile

node with simple IP capabilities can move between wireless networks without loss of service. 3Com did not provide Motorola with such a system. While some of the claims utilize Packet Data Serving Nodes (PDSNs), which are equivalent to MARC cards, those claims include other aspects that were not associated with the Motorola agreement. For example, many of the claims call for a proxy server to interface with the PDSN. 3Com did not sell or offer to sell such a proxy server to Motorola at any time before the critical date. 3Com was developing a proprietary proxy server for the HAAA server known as a High Availability Radius Proxy (HARP) server with the capability of interfacing with the MPA, however, again this server was never sold or offered for sale to Motorola prior to the critical date. Indeed, a HARP with the MPA capabilities was not released by 3Com until August of 2000. While, pursuant to the non-disclosure agreement, Motorola was allowed access the evolving HARP technology, Motorola's use was restricted to use solely for testing purposes. The agreement with Motorola involved only the development of a MPA for use on the MARC card in the communication system.

### **Discussion of Legal Significance**

In order for an invention to be on sale two events must occur: First, the invention must be ready for patenting; and second, it must be the subject of an offer for sale. *Pfaff v. Wells Electronics*, 525 U.S. 55 (1998). In the arrangement with Motorola, neither event occurred. First and foremost prior to the critical date the invention was not ready for patenting. The Supreme Court stated in *Pfaff* that an invention is ready for patenting if "the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id* at 67-68. In this case the MARC card software with MPA functionality was only one element of the invention. The invention as a whole was still evolving with both the MPA and the HARP being fully developed. In particular, in order to

have any expectation that it would work within the claimed system, the MPA functionality has to be tested within the system. As noted above this testing was not completed until after the critical date. Thus, the invention was not ready for patenting until after the critical date and could not have been the subject of a sale.

In addition, the agreement with Motorola did not even involve the claimed MPA invention. As noted above, the HARP proxy server, or any server having the claimed MPA functionality, was never part of the agreement with Motorola. As the server is an explicit element of the claims, this is a clear indication that the invention was never the subject of on sale activity. More specifically the invention, even if it was ready for patenting was not the subject of an offer for sale.

While the agreement may at first blush seem to impact the patentability of the present invention, all the activities were confidential. Thus, they do not fall within the scope of the prior art and the activities do not amount to a sale or offer for sale of the present invention. Therefore, upon thorough analysis, the agreement with Motorola is of limited relevance to the present case. However, to ensure that the Office is aware of all the facts, 3Com has brought the agreement to the attention of the Office.

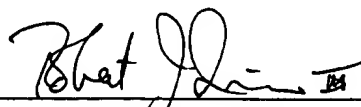
Respectfully submitted,


**McDonnell Boehnen Hulbert & Berghoff**

Date:

5/29/03

By:

  
**Robert J. Irvine**  
**Registration No. 41,865**

Form PTO-1449 U.S. Department of Commerce Patent and Trademark Office  <b>SUPPLEMENTAL          INFORMATION DISCLOSURE          STATEMENT BY APPLICANT</b>  	Atty. Docket No. 01-298	Serial No. 09/849.834
	Applicant: Raman, et al.	
	Filing Date: May 4, 2001	Group: 2681

### U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date

### FOREIGN PATENT DOCUMENTS

Document Number	Date	Country	Class	Subclass	Translation Yes No

### OTHER DOCUMENTS - Including Author, Title, Date, Pertinent Pages, Etc.

1.	Declaration for U.S. Patent Application 09/849,834, filed on May 4, 2001.
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<b>Examiner</b>	<b>Date Considered</b>
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with any communication.



Hon. Commissioner of  
Patents and Trademarks

S/N: 09/849,834

Atty RJJ/es

Re: Applicant - Raman et al.

Case No. 01-298

"System And Method To Allow Simple IP Mobile Nodes To Operate  
Seamlessly In A Mobile IP Network With True Roaming Capabilities"

Sir:

Please place the Patent Office receipt stamp hereon and mail to acknowledge receipt of:

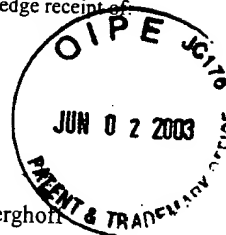
- (1) Transmittal Letter in duplicate;
- (2) Information Disclosure Statement;
- (3) Form PTO-1449; and
- (4) One IDS citation (Declaration for U.S. Patent Application 09/849,834).

Fee Enclosed

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Date Mailed: May 29, 2003

Respectfully,  
McDonnell Boehnen Hulbert & Berghoff  
Attorney for Applicant



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